

A3
the 3-position of said picolinic acid residue being substituted by hydroxy, C₁₋₆ alkylcarbonyloxy, benzoyloxy, C₁₋₆ alkoxy carbonyloxy, C₁₋₆ alkyloxycarbonyl C₁₋₁₀ alkylcarbonyloxy, benzyloxycarbonyl C₁₋₁₀ alkylcarbonyloxy, carboxy C₁₋₁₀ alkylcarbonyloxy, C₁₋₆ alkylphosphoryloxy, di(C₁₋₆)alkylphosphoryloxy, or diphenylphosphoryloxy.

27. (New) The compound or salt thereof according to claim 21, wherein the C₁₋₆ alkoxy is methoxy.

28. (New) A pharmaceutical composition comprising the compound or a salt thereof according to any one of claims 1, 20 or 21 and a pharmaceutically acceptable carrier.

REMARKS

Further and favorable reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

Initially, the specification has been amended to insert a cross-reference to the International Application on which the present U.S. application is based.

Claims 8, 11 and 16-18 have been canceled.

Claims 1, 2, 9, 10 and 12-15 have been amended.

Claim 1 has been amended to exclude certain aromatic carboxylic residues from the definition of R², and also to limit R³ to a hydrogen atom. The significance of these limitations will be discussed below.

Claim 2 has been amended to correct the spelling of "substituent" in line 5 of original claim 2.

Claims 9 and 10 have been amended to depend from new claim 20 or 21 (discussed below).

Claims 12-15 have been amended to depend from claim 1, 20 or 21.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

New claims 20-28 have been added to the application.

New claims 20 and 21 correspond to original claim 1, but limit the definitions of R^2 and R^3 .

New claims 22-27 correspond to original claims 2-7, respectively, but are dependent on new claim 21.

New claim 28 is directed to a pharmaceutical composition, following the suggestion of the Examiner in connection with the rejection of claims 16 and 17 under the second paragraph of 35 U.S.C. § 112.

In view of the amendments to the claims, it is apparent that the rejection of claim 11 under 35 U.S.C. § 101, as well as the rejection of claims 16 and 17 under 35 U.S.C. § 112, have been rendered moot.

The patentability of the present invention over the disclosures of the references relied upon by the Examiner in rejecting the claims will be apparent upon consideration of the following remarks.

Thus, the rejection of claims 1, 11 and 13-18 under 35 U.S.C. § 102(a) as being anticipated by Hanafi et al. is respectfully traversed.

The Examiner states that two compounds, "2-Butenoic...ester", i.e. UK-2B, and "(2E)-and Butenoic...ester", i.e. UK-2C, are taught in Hanafi et al. This reference describes UK-2B and UK-2C as well as UK-2A, UK-2D and Me-UK-2A in Fig. 1 at page 1226, but the UK-2A, UK-2B, UK-2C, UK-2D and Me-UK-2A are excluded from original claim 1. These compounds are now also excluded from amended claim 1. Additionally, the compounds of new claims 20 and 21 are different from those of the reference since R^3 in these new claims does not represent a hydrogen atom.

Thus, the present invention is considered to be patentable over the Hanafi et al. reference.

The rejection of claims 1, 11 and 13-18 under 25 U.S.C. § 102(a) as being anticipated by Shimano et al. (August 1998), as well as the rejection of claims 1, 11 and 13-18 under 35 U.S.C. § 103(a) as being unpatentable over Shimano et al. (August 1998) and the rejection of claims 1, 11 and 13-18 under 35 U.S.C. § 103(a) as being unpatentable over Shimano et al. (April 1998), are respectfully traversed.

As noted by the Examiner, the Shimano et al. references were published in August 1998 and April 1998, which are subsequent to the filing date of February 6, 1998 for Applicants' Japanese

priority application. Therefore, obtaining the benefit of the Japanese priority date will be effective to overcome these references.

A certified copy of Applicants' Japanese priority application is already of record, as acknowledged by the Examiner. A verified English translation of the priority application is submitted herewith.

Considering the disclosure of the Japanese priority application, as shown by the translation, Applicants take the position that the Shimano et al. references are not available as prior art against the present invention.

Particular attention in this regard is directed to the fact that amended claim 1 set forth above corresponds to claim 1 of the Japanese priority application; and new claim 20 set forth above corresponds to claim 6 of the priority application.

In addition, new claim 21 is directed to compounds which are clearly distinguishable from Antimycin A₃ (of Shimano et al.) specifically mentioned by the Examiner, since the compounds of claim 21 have a dilactone structure with a nine-membered ring where the 2-position is a hydrogen atom and the 8-position is benzyl, while Antimycin A₃ has a dilactone structure with a nine-membered ring where the 2-position is methyl and the 8-position is n-butyl. These two chemical structures are clearly different from each other. Accordingly, one of ordinary skill in the art would not obtain a suggestion of the compounds of new claim 21 based on Antimycin A₃.

Furthermore, as stated above, the compounds of new claim 21 are different from UK-2A since R³ defined in formula (I) of new claim 21 does not represent a hydrogen atom. One of ordinary skill in the art would not replace a hydrogen atom with a nitro, amino, acylamino, or N,N-dialkylamino as the substituent R³ defined in formula (I) of new claim 21. Selecting nitro, amino, acylamino, or N,N-dialkylamino from among many substituents is not suggested.

In addition, Hanafi et al. and Shimano et al. (April 1998) disclose only UK-2A and Antimycin A₃, and nowhere disclose or suggest derivatives of these compounds, a process for the preparation thereof, or antifungal activity of the derivatives. Accordingly, one of ordinary skill in the art would not obtain a suggestion of the compounds of new claim 21 based on UK-2A.

For the reasons set forth above, Applicants take the position that the presently claimed invention is clearly patentable over the applied references.

Therefore, in view of the foregoing amendments and remarks, it is submitted that each of the grounds of objection and rejection set forth by the Examiner has been overcome, and that the application is in condition for allowance. Such allowance is solicited.

Respectfully submitted,

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